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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/522,003      | 01/14/2005  | Takaya Yamauchi      | 58006US005          | 5085             |

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| EXAMINER |
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PETKOVSEK, DANIEL J

| ART UNIT | PAPER NUMBER |
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2874

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

**Office Action Summary**

Application No.

10/522,003

Applicant(s)

YAMAUCHI ET AL.

Examiner

Daniel J. Petkovsek

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on IDS filed February 10, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 14, 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/06; 1/14/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to the pre amendment filed January 14, 2005. Claim 6 has been amended to better conform to U.S. practice. Claims 1-6 are pending.

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

2. The prior art documents submitted by Applicant in the Information Disclosure Statements filed on February 10, 2006, and January 14, 2005, have been considered and made of record (note attached copy of forms PTO-1449).

#### ***Specification***

3. The abstract of the disclosure is objected to because an official abstract is required in response to this office action. Currently, a PCT abstract is listed. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: continuing data (i.e. PCT data) listed on the Bib data sheet must be added into the first paragraph of the specification.

Appropriate correction is required.

#### ***Claim Objections***

5. Claims 1, 2, and 5 are objected to because of the following informalities: Regarding claims 1 and 2, "...buffer retainers for opposing *to the* buffer coatings...", should be replaced with, "...buffer retainers for opposing *the* buffer coatings...". Regarding claim 5, in the third

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line, "a second tongue-shaped member" lacks antecedent basis, since there is no *first* tongue-shaped member. Appropriate correction is required.

### *Drawings*

6. Figures 15-20 should be designated by a legend such as --**Prior Art**-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. U.S.P. No. 5,708,746.

Kim et al. U.S.P. No. 5,708,746 teaches (ABS; Figs. 1, 4; column 3, line 57 through column 4, line 30; column 5, lines 4-38) a splicing member for splicing optical fiber each having a bare fiber coated with a buffer coating, comprising: a joint element 12 for retaining the bare fibers 13 in a state in which the bare fibers are butt-jointed against one another; a jacket 1 including an element storage part/area for storing the joint element, optical fiber

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passages/grooves 5 for guiding optical fibers 13 to end parts of the joint element stored in the element storage part respectively, and buffer retainers 3 for opposing the buffer coatings of the optical fibers 13 when the optical fibers are extending along the passages/grooves, and pressing parts 4 that press down on the buffer retainers 3 to clamp/clasp the buffer coating portions of the fibers when said fibers are extending in the fiber passages/grooves, which clearly, fully meets Applicant's claimed limitations.

Regarding claim 2, caps 4 are mounted to the jacket 1 and are movable in orthogonal directions (see Fig. 4) and this movement causes a pressing action to engage the joint to create an integral holding feature for holding/pressing the optical fibers, the caps 4 acting as both a "cap" and a "pressing part", since portions of element 4 do both functions.

### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. U.S.P. No. 5,708,746.

Kim et al. U.S.P. No. 5,708,746 teaches (ABS; Figs. 1, 4; column 3, line 57 through column 4, line 30; column 5, lines 4-38) a splicing member for splicing optical fiber each having a bare fiber coated with a buffer coating, comprising: a joint element 12 for retaining the bare fibers 13 in a state in which the bare fibers are butt-jointed against one another; a jacket 1 including an element storage part/area for storing the joint element, optical fiber

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passages/grooves 5 for guiding optical fibers 13 to end parts of the joint element stored in the element storage part respectively, and buffer retainers 3 for opposing the buffer coatings of the optical fibers 13 when the optical fibers are extending along the passages/grooves, and pressing parts 4 that press down on the buffer retainers 3 to clamp/clasp the buffer coating portions of the fibers when said fibers are extending in the fiber passages/grooves, wherein caps 4 are mounted to the jacket 1 and are movable in orthogonal directions (see Fig. 4) and this movement causes a pressing action to engage the joint to create an integral holding feature for holding/pressing the optical fibers, the caps 4 acting as both a “cap” and a “pressing part”, since portions of element 4 do both functions.

Kim et al. U.S.P. No. 5,708,746 does not *explicitly* teach tongue-shaped, engagement parts, pressing members that press and hold the optical fibers (claims 3-5). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a number of well known forms for clamping/pressing/holding an optical component for proper stability and control because Applicant has not disclosed that using tongue-shaped/projecting member/pressing member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the disclosed presser member, since the stability of the optical fiber splicing system due to the presser/clamp functionality of the Kim et al. '746 reference is essential to result in proper optical fiber splicing. If the pressing mechanism of Kim et al. '746 did not successfully clamp and hold the optical fibers, the device would not be functional in the optical art. Therefore, it would have been an

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obvious matter of design choice to modify Kim et al. '746 to obtain the invention as specified in claims 3-5.

Regarding claim 6, Kim et al. '746 does not *explicitly* teach end plugs/caps that extend in the same direction of the optical fiber passages and are fitted integrally with the jacket.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to employ distinct end caps that are formed on the ends of the jacket. The end section of Kim et al. '746 can be viewed as a "capping" region, but are not explicitly disclosed as "end caps". A person having ordinary skill in the art at the time the invention was made would have recognized that these components have the same functionality, to protect and prevent outside stimuli from ruining the optical fiber splicing and coupling, and as such, having separate end caps does not patentably distinguish from the Kim et al. '746 reference.

### *Conclusion*


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, with respect to the state of the art of optical fiber splicing structures that provide protection and pressing functionality: PTO-892 form references B and C.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Petkovsek whose telephone number is (571) 272-2355. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Petkovsek  
February 28, 2006

  
AKM ENAYET ULLAH  
PRIMARY EXAMINER